REMARKS

This is a full and timely response to the Office Action mailed June 19, 2003. Reconsideration and allowance of the application and presently pending claims are respectfully requested.

Present Status of Patent Application

Upon entry of the amendments in this response, claims 1-6 and 20-30 remain pending in the present application. More specifically, claims 1-6 have been currently amended, claims 7-19 have been canceled without prejudice, waiver or disclaimer, and claims 20-30 have been newly added. It is believed that the foregoing amendments add no new matter to the present application.

Reconsideration and allowance of the application and presently pending claims are respectfully requested.

A. Claim Rejections - 35 U.S.C. § 103(a)

a) Statement of the rejection

The Office Action states that claims 1-19 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over prior art disclosed by Applicant (see page 2, line 6 – page 8, line 30, and, Figures 1 and 2 of the instant application) in view of Kouno et al. (US 5,233,291).

b) Response to the rejection

Claim 1

Claim 1 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over prior art disclosed by applicant in view of Kouno. In this regard, the Office Action states in pertinent part, that "With regard to claim 1, prior art teaches a system and method for measuring a distance between materials, comprising...." (Emphasis added), and continues, in paragraphs B and C, to describe methods disclosed in the prior art.

Claim 1 is a *system* claim and not a method claim, and such assertions based on prior art *methods* makes it appear that the Office Action is drawing improper conclusions based on inherent teachings that are alleged to be present in methods described by Kouno. Such an action overlooks the law surrounding inherent teachings. Applicant respectfully submits that the rejection of claim 1 based on such assertions constitutes legal error and is contrary to well-established Federal Circuit precedence regarding this law. In fact, the undersigned respectfully directs the Examiner's attention to the recent decision of Elan Pharms. v. Mayo Found. for Med. Educ. & Research, 304 F.3d 1221 (Fed. Cir. 2002), in which the Federal

Circuit reversed a finding of inherency by a district court. In this opinion, the Court of Appeals for the Federal Circuit noted:

> An anticipating reference "must disclose every element of the challenged claim and enable one skilled in the art to make the anticipating subject matter." *PPG Industries, Inc. v. Guardian Industries Corp.*, 75 F.3d 1558, 1566, 37 USPQ2d 1618, 1624 (Fed. Cir. 1996). When anticipation is based on inherency of limitations not expressly disclosed in the assertedly anticipating reference, it must be shown that the undisclosed information was known to be present in the subject matter of the reference. *Continental Can Co. USA, Inc. v. Monsanto Co.*, 948 F.2d 1264, 1269, 20 USPQ2d 1746, 1749-50 (Fed. Cir. 1991). ***An inherent limitation is one that is necessarily present; invalidation based on inherency is not established by "probabilities or possibilities."*** *Scaltech, Inc. v. Retec/Tetra, LLC.*, 178 F.3d 1378, 1384, 51 USPQ2d 1055, 1059 (Fed. Cir. 1999).

In the present situation, the Office Action has, unfortunately, substituted its own subjective judgment in place of the actual teachings of the cited prior art references. In this connection, attention is drawn to the Office Action assertions such as "Kouno et al (Kouno hereinafer) teaches the principle of gap measurement..," "it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the old and well known method of measuring gap as disclosed by Kouno...," and "Subtracting an "offset" distance from a measured distance is old and well known in the art."

Claim 1 identifies a *system* for measuring a distance, and Applicant respectfully asserts that it *is improper to assert that such a system would be inherently taught by the cited methods and principles described in Kouno.*

Furthermore, Applicant respectfully asserts that the rejection of claim 1 is improper because it does not conform to MPEP guidelines for a rejection under 35 U.S.C. 103(a).

To quote MPEP 706.2(j) *Contents of a 35 U.S.C. 103 Rejection*, in pertinent part:

> To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP § 2143 - § 2143.03 for decisions pertinent to each of these criteria.
> (Emphasis added)

The cited prior art does not expressly or impliedly provide some suggestion or motivation to one of ordinary skill in the art to modify either reference or to combine the cited references, and Applicant notes with regret that the Office Action does not indicate where a teaching or suggestion of the above-quoted motivation may be found in the cited references.

On the subject of teaching in the prior art, the Office Action cites Kouno (col. 11, lines 44-51) as follows:

> "Note: Kouno teaches of a projection 201 (an electrode) of precisely known thickness T_e mounted on a first material 4, in comparison to applicant's slot 310 of precisely known depth in a first material 304. Kouno determines the distance G_e between two materials by subtracting a measured distance G from a known distance T_e The applicant also determines the distance 308 between two materials by subtracting a measured (cavity) distance 322 from a known distance 312 (depth of slot). Subtracting an "offset" distance from a measured distance is old and well known in the art."

Drawing attention to lines in Kouno that immediately follow the cited lines (col. 11, lines 44-51), it can be seen that lines 52 – 56 state, "*In order to eliminate the calculation of Equation (12), the electrode 201 can be fully embedded in the prism* 4 so that the bottom surface of the electrode 201 becomes even with that of the prism 4; this makes the value of Te equal to zero." Consequently, Applicant respectfully asserts that rather than providing a suggestion or motivation to provide an offset for measurement purposes, Kouno ***teaches away*** from such an offset.

Furthermore, it is respectfully asserted by the Applicant that the Office Action improperly equates a structure of Kouno's "*projection* 201 (an electrode)" to a structure of Applicant's "*slot*." Applicant fails to find in Kouno any pertinent reference to a "slot," let alone the need for "improving such a slot," whereby such a need for improvement may be possibly interpreted as a motivation to combine.

Therefore, Applicant asserts that the Office Action rejection of claim 1 under 35 U.S.C 103(a) is improper because neither the prior art cited by the Applicant nor Kouno expressly or impliedly provide some suggestion or motivation to one of ordinary skill in the art, to modify either reference or to combine the two references.

Applicant submits that the combination of the cited references fails to disclose, teach, or suggest each element in claim 1. In this connection, Applicant draws attention to the Office Action statement that admits "prior art does not teach of a slot disposed in the first material...," the prior art referred to here, being the prior art admitted by Applicant in his original application. The Office Action, however, in a subsequent assertion erroneously insists that "Kouno et al (Kouno hereinafter) teaches the principle of gap measurement..." Consequently, Applicant asserts that the combination of prior art references do not teach or suggest all the

claim limitations of Applicant's system claim 1. Specifically, the combination fails to suggest or teach at least Applicant's slot disposed in a first optical material.

Consequently, Applicant respectfully asserts that the Office Action rejection of claim 1 under 35 U.S.C 103(a) is improper because the proposed combination of prior art cited by applicant and Kouno do not expressly or impliedly suggest all of the features/limitations recited in Applicant's claim 1.

In conclusion, the Office Action fails to establish a *prima facie* case of obviousness as it does not provide a reason to combine prior art cited by applicant and Kouno; and also does not provide in the combination of prior art cited by applicant and Kouno, a combination that expressly or impliedly suggests all of the features/limitations recited in Applicant's claim 1.

Currently amended claim 1 includes "a distance-measurement-offset slot disposed in the first optical material," wherein the structure of the slot is further defined "by a slot surface" Applicant has failed to find in prior art cited by applicant and in Kouno, a suggestion or teaching of at least such a slot as defined in claim 1.

Consequently, Applicant requests that rejection of claim 1 be withdrawn, and that claim 1 be allowed.

Claim 2

Claim 2 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over prior art disclosed by applicant in view of Kouno. In this regard, the Office Action states in pertinent part, "Claim 2 is rejected because their limitations are an extension and/or duplication of the limitations of rejected claim 1." The Office Action further asserts that "It would have been obvious to one of ordinary skill in the art at the time invention was made to subtract the precisely known distances/depths of a first and the second slot..."

In addition to lacking 103(a) foundation for a rejection of the first slot, the Office Action fails to reveal how the cited prior art would suggest or make obvious a second slot. The inherent implication that a first slot would automatically suggest the incorporation of a second slot, (and maybe more such slots) is illogical, especially given the fact that the cited prior art does not disclose even one "slot," let alone a slot in a distance measurement system.

Curently amended claim 2 includes "a second distance-measurement-offset slot disposed in the second optical material," and wherein the structure of the slot is further defined as "comprising a slot surface" Applicant has failed to find in prior art cited by applicant and Kouno, at least such a second slot as defined in claim 2.

Furthermore, as currently amended independent claim 1 is allowable, claim 2 that depends on claim 1, is also allowable as a matter of law. *In re Fine*, 837 F. 2d 1071 (Fed. Cir. 1988).

Applicant therefore requests that claim 2 be allowed.

Claim 3

Claim 3 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over prior art disclosed by applicant in view of Kouno. In this regard, the Office Action states in pertinent part, that "With regard to claim 1, prior art teaches a system and method for measuring a distance between materials, comprising...." (Emphasis added), and continues in paragraph A, to describe the structure of the prior art.

Claim 3 is a *method* claim, and several assertions in paragraph A that are based on prior art *systems*, overlooks the law surrounding inherent teachings. In the context of MPEP 706.2(j), the cited prior art does not expressly or impliedly provide some suggestion or motivation to one of ordinary skill in the art to modify either reference or to combine the cited references, and the Office Action does not indicate where such a teaching or suggestion of the above-quoted motivation may be found in the cited references.

On the subject of teaching in the prior art, the Office Action asserts that

> "In view of Kouno's teaching, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the old and well known method of measuring gap as disclosed by Kouno into prior art measurement system and method due to the fact that such incorporation would provide a system that can accurately measure gaps smaller than 10 microns using a conventional gap measuring system. Accordingly, such incorporation would have constituted an alternative means/obvious engineering expedience for one of ordinary skill in the art at the time the invention was made." (Emphasis added)

Drawing attention to lines in Kouno that immediately follow the cited lines (col. 11, lines 44-51), it can be seen that lines 52 – 56 state, "*In order to eliminate the calculation of Equation (12), the electrode 201 can be fully embedded in the prism* 4 so that the bottom surface of the electrode 201 becomes even with that of the prism 4; this makes the value of Te equal to zero." Consequently, Applicant respectfully asserts that rather than providing a suggestion or motivation to provide an offset for measurement purposes, Kouno *teaches away* from using such an offset.

Furthermore, it is respectfully asserted by the Applicant that the Office Action improperly equates Applicant's use of a "slot" to Kouno's use of a "projection 201 (an electrode)." In this context, while Kouno does not expressly or impliedly provide some suggestion or motivation for one of ordinary skill in the art to modify the prior art cited by

Applicant, Applicant further fails to find in Kouno any reference to use of a "slot," let alone the need for "improving such a slot," whereby such a need for improvement may be possibly interpreted as a motivation to combine.

Therefore, Applicant asserts that the Office Action rejection of claim 3 under 35 U.S.C 103(a) is improper because neither the prior art cited by the Applicant nor Kouno expressly or impliedly provide some suggestion or motivation to one of ordinary skill in the art, to modify either reference or to combine the two references.

Applicant submits that the combination of the cited references fails to disclose, teach, or suggest each element in claim 3. In this connection, Applicant draws attention to the Office Action statement that it would have been obvious to one of ordinary skill in the art that Kouno's method discloses a "system that can accurately measure gaps smaller than 10 microns using a conventional gap measuring system." Applicant fails to find in Kouno such disclosure, let alone mention of a measuring method using a slot.

In the present situation, it appears the Examiner has, unfortunately, substituted his own subjective judgment in place of the actual teachings of the cited prior art references.

Consequently, if the proposed rejection is based on at least facts that remain within the personal knowledge of the Examiner. Applicant hereby requests an affidavit from the Examiner fully supporting the statement of the rejection in the Office action in accordance with 37 CFR § 1.104(d)(2).

Applicant respectfully asserts that the Office Action rejection of claim 3 under 35 U.S.C 103(a) is improper because the proposed combination of prior art cited by applicant and Kouno do not expressly or impliedly suggest all of the features/limitations recited in Applicant's claim 3.

In conclusion, the Office Action fails to establish a *prima facie* case of obviousness as it does not provide a reason to combine prior art cited by applicant and Kouno; and also does not provide in the combination of prior art cited by applicant and Kouno, a combination that expressly or impliedly suggests all of the features/limitations recited in Applicant's claim 3.

Currently amended claim 3 includes "using a distance-measurement-offset slot disposed in at least one of the two optical materials." Applicant has failed to find in prior art cited by applicant and Kouno, a suggestion or teaching of at least such a step as defined in claim 3.

Consequently, Applicant requests that rejection of claim 3 be withdrawn, and that claim 3 be allowed.

Claims 4-6

Claims 4-6 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over prior art disclosed by applicant in view of Kouno. As currently amended independent claim 3 is allowable, claims 4-6 that depend on claim 3, are also allowable as a matter of law for at least the reason that dependent claims 4-6 contain all the steps of independent claim 3. *In re Fine*, 837 F. 2d 1071 (Fed. Cir. 1988).

Applicant therefore requests that claims 4-6 be allowed.

Claims 7-19

Claims 7-19 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over prior art disclosed by applicant in view of Kouno. Claims 7-19 are cancelled without prejudice, waiver, or disclaimer, and therefore, the rejection to these claims are rendered moot. Applicant takes this action merely to reduce the number of disputed issues and to facilitate early allowance and issuance of other claims in the present application. Applicant reserves the right to pursue the subject matter of these cancelled claims in a continuing application, if Applicant so chooses, and does not intend to dedicate any of the cancelled subject matter to the public.

B. Invention Disclosure Statement

At page 2 of the Office Action, it is noted that the "listing of references in the specification is not a proper information disclosure statement" and that a disclosure under 37 C.F.R. §1.98 is required. Applicants submit herewith an information disclosure statement.

C. Objection to the Specification

At page 2 of the Office Action, the "disclosure is objected to because of the following informality: The citation of U.S. Patent 5,642,196 (page 1, lines 11-14) is repeated in lines 28-30 (page 1)." The Specification is amended herein and Applicants respectfully request that the objection be withdrawn.

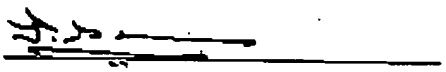
Prior Art Made of Record

The prior art made of record has been considered, but is not believed to affect the patentability of the presently pending claims.

CONCLUSION

In light of the foregoing amendments and for at least the reasons set forth above, Applicant respectfully submits that all objections and/or rejections have been traversed, rendered moot, and/or accommodated, and that claims 1-6 and 20-30 are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned at (770) 933-9500.

Respectfully submitted,



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